

**REMARKS**

The application has been reviewed in light of the Office Action dated April 1, 2008.

Claims 1-22 are pending in this application. By the present Amendment, claims 3, 5-7, 13 and 14 have been amended and claims 17-23 have been added. It is submitted that no new matter has been added and no new issues have been raised by the present Amendment.

Claims 1-16 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. The claims have been carefully reviewed and amended with particular attention to the points raised in the Office Action. Withdrawal of the rejection under Section 112, second paragraph, is respectfully requested.

Claims 1-3, 7, 8, 10, 13, 15 and 16 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent 3,042,975 to Bingham et al. in view of U.S. Patent 5,032,330 to Auberry et al. (the Auberry '330 patent) and U.S. Patent 3,965,517 to Auberry et al. (the Auberry '517 patent.) Claims 5, 9, 11 and 12 were rejected under Section 103(a) as allegedly unpatentable over Bingham et al. and the Auberry patents and further in view of U.S. Patent 1,530,297 to Byrne et al. Claim 6 was rejected under Section 103(a) as allegedly unpatentable over Bingham et al. in view of the Auberry patents and further in view of U.S. Patent 4,651,444 to Ours et al. Applicant has carefully considered the Examiner's comments and the cited art, and respectfully submits independent claim 1 is patentable over the cited art, for at least the following reasons.

Independent claim 1 relates to a method for moulding soles of a plastic material and shoe welts on shoe uppers by use of a mould so as to provide the finished shoe with a welted appearance. The mould includes a last, upon which a shoe upper is arranged, an upper mould part divided

along a longitudinal middle plane and thus including two halves being laterally movable in relation to a lower mould part between an open and a closed mould position, and a lower mould part being vertically movable in relation to the upper mould part between an open and a closed mould position. The method comprises an annular welt is provided having an inner outline substantially corresponding to the outer outline of the lower side section of the shoe upper which corresponds to the position of the welt on the finished shoe. The welt is placed in the mould in the open position of the mould. The two halves of the upper mould part are brought together, whereby an upper projection on each of the halves extends over the welt. The lower mould part is moved into its closed position, a circumferential support face on the upper face of the lower mould part co-acting with a pressure surface on the lower face of the projection on each of the upper mould part halves in such a manner that the portion of the welt facing the shoe upper is tilted inwards and downwards to bring the inner end face of the welt into sealing engagement with the lower side section of the shoe upper. The shoe sole is molded by supplying a plastic material to the cavity of the mould before or after the lower mould part is moved into its closed position.

Bingham et al., as understood by Applicant, relates to a method for manufacturing a shoe with a welt 14 and a rubbery outer sole 12 molded to the upper. The method utilizes a molding apparatus for molding the outer sole 12 and simultaneously forming corrugated welt 14. The molding apparatus includes a last 22 for an upper 10, a bottom plate 24 and a ring mold member 26 extending around the periphery of the last and having an inwardly projecting overhanging flange 28 at its upper edge. A thin strip (ribbon) of vulcanizable rubber 14x is applied to sole blank 12x. The ribbon 14x and blank 12x are placed in the mold with an upper 10. The parts are then molded and heat is applied to simultaneously mold and vulcanize the parts together.

As conceded in the Office Action, Bingham et al. does not teach or suggest that the soles are molded from plastic material and that plastic material is supplied to the cavity of the mold. Furthermore, and as acknowledged in the Office Action, Bingham et al. does not teach or suggest a circumferential support face on the upper face of the lower mold part (4). Finally, and contrary to the comments in the Office Action, Bingham et al. is not understood to teach or suggest that the support face co-acts with the lower face of the projection in such a manner that the portion of the welt facing the shoe upper is tilted inwards and downwards to bring the inner end face of the welt into sealing engagement with the lower side section of the shoe upper.

The Auberry '330 Patent, as understood by Applicant, relates to a method for manufacturing footwear. A mold 18 has a cavity 28. A sole member 29 is placed in the mold cavity so as to conform the shape thereof. A last 5 having a shoe upper 1 thereon is provided. A welt 12 is secured to the shoe upper 1, by a stitch 30. The welt 12 is positioned against the sole member 29 along the perimeter of the cavity to form an enclosed space between the last 5, the welt 12 and the resilient sole member 29. A foamable material is then foamed within the enclosed space.

As conceded in the Office Action, the Auberry '330 Patent does not teach or suggest a lower mold part comprising a support face on the upper face to support the welt and co-act with a pressure surface on the lower face of the position of the upper mold part.

Furthermore, the Auberry '330 Patent does not teach or suggest that the support face and the pressure surface co-act in such a manner that the portion of the welt facing the shoe upper is tilted inwards and downwards to bring the inner end face of the welt into sealing engagement with the lower side section of the show upper.

It is important to note that in the Auberry '330 Patent, the welt 12 is attached to a bottom portion of the shoe upper 1 and not to a lower side section thereof.

Finally the Auberry '330 Patent does not teach or suggest placing the welt in the open position of the mold. In Auberry the welt is not placed in the mold until the upper and lower mold parts have been moved in to their closed position.

The Auberry '517 Patent, as understood by Applicant, relates to a method of manufacturing footwear. A pre-welted upper 1 is placed upon a last 5. That is, in the Auberry '517 Patent the welt 12 is also secured to the upper 1.

However, the Auberry '517 Patent does not teach or suggest placing the welt in the mold in the open position of the mold. For example, in the Auberry '517 Patent, the welt is not placed in the mold until the upper and lower mold parts have been moved into their closed position.

Furthermore, the Auberry '517 Patent does not teach or suggest that when the lower mold part is moved into its closed position, a support face on the upper face of the lower mold part co-acts with a pressure surface on the upper mold part in such a manner that the portion of the welt facing the shoe upper is tilted inwards and downwards to ring the inner end face of the welt into sealing engagement with the lower side section of the shoe upper.

Furthermore, as noted above, the Auberry '517 Patent, teaches attaching the welt 12 to a bottom portion of the shoe upper 1 and not to a lower side section thereof.

The Office Action contends that it would have been obvious to a person of ordinary skill to combine the teachings of Bingham et al. with the Auberry Patents. In particular, the Office Action contends that it would have been obvious to use the lower mold taught by the Auberry '517 Patent allegedly having an upper support face with the upper mold part allegedly taught by

Bingham et al. allegedly having a lower face of the projecting flange, in order for the welt to tilt upwards and/or downwards to bring the inner face of the welt into sealing engagement with the lower side section of the shoe upper when both mold parts are moved towards the last supporting the shoe upper and form a closed position of the mold.

Applicant respectfully submits that it is only the result of hindsight that the references are combined as indicated in the Office Action. Firstly, as explained above, none of the cited documents teaches or suggests that the inner portion of the welt is tilted inwards and downwards to bring the inner face of the welt into sealing engagement with the lower side section of the shoe upper, as recited in independent claim 1. In fact, both of the Auberry Patents teach away from tilting the inner portion of the welt in order to bring it into sealing engagement with the lower side section of the shoe upper when the lower mold part is moved into its closed position, since they both teach that the welt is secured to a portion of the upper (i.e. prewelted, prior to being arranged in the mold.)

Further, both Auberry Patents teach that the two halves of the upper mold part are brought together before arranging the welt in the mold. Accordingly, Applicant finds no teaching or suggestion that the welt is placed in the mold in the open position of the mold, as also recited in independent claim 1.

Also, Bingham et al. teaches away from tilting in the portion of the welt inwards and downwards to bring it into sealing engagement with the side section of the upper when the lower mold part is moved into its closed position, since in Bingham et al., the welt is arranged on the upper surface of the sole blank of vulcanizable rubber.

Accordingly, Applicant submits independent claim 1 is patentable over the cited art.

The Office is hereby authorized to charge any additional fees that may be required in connection with this amendment and to credit any overpayment to our Deposit Account No. 03-3125.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition, and the Commissioner is authorized to charge the requisite fees to our Deposit Account No. 03-3125.

If a telephone interview could advance the prosecution of this application, the Examiner is respectfully requested to call the undersigned attorney.

Entry of this amendment and allowance of this application are respectfully requested.

Respectfully submitted,



RICHARD F. JAWORSKI  
Reg. No. 33,515  
Attorney for Applicant  
Cooper & Dunham LLP  
Tel.: (212) 278-0400